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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,407	02/10/2000	Harry A. Glorikian	P690CIP1	5124

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CENTRAL COAST PATENT AGENCY
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EXAMINER

BHATIA, AJAY M

ART UNIT PAPER NUMBER

2145

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/502,407		GLORIKIAN, HARRY A.	
	Examiner		Art Unit	
	Ajay M. Bhatia		2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments with respect to claims 1,4,7 have been considered but are moot in view of the new ground(s) of rejection.

Applicant has failed to address the 101 rejection therefor it is maintained.

Applicant has filed an terminal disclaimer with 6,081,780, which is accepted. But it the application still fails to overcome the double Patenting rejection bellow.

Applicant has amended to the claim "subject categories or specific sub-categories of for a user," but argues "subject categories and specific sub-categories of for a user" which is not present in the claim. Therefore arguments addressing a limitation not present are not considered. The cited portion of Lumelsky address the current limitation.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., subject categories and specific sub-categories of for a user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The repository is not tangibly limited to a product that is within and enabled by the specification. Also, claim 1 discloses only data structures.

Claim 1 is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim 4 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A code set is not tangibly limited to a product that is within and enabled by the specification. Also, claim 1 discloses data structures. Claim 4 is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 of USPN 6,343,317 contains every element of claims 1, 4 and 7 of the instant application and as such anticipates claims 1, 4 and 7 of the instant application.

“A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hancock et al. ("Hancock"), USPN 6,202,023, in view of Lumelsky, USPN 6,081,780.

Regarding claim 1, Hancock discloses a multi-dimensional information repository, comprising: a plurality of data categories identified by geographic regions [Hancock, col. 5, line 53 – col. 6, line 64, col. 9, lines 42–64 and col. 27, line 28 – col. 28, line 22]; a plurality of stored data entities in each of the data categories identified according to position in one of the geographic regions [Hancock, col. 11, line 55 – col. 12, line 7, col. 19, line 48 – col. 20, line 15, col. 26, lines 12-41 and col. 27, line 28 – col. 28, line 22]; a user preference [Hancock, col. 29, lines 25-28 and col. 30, lines 1-10]; a data retrieval system [Hancock, col. 27, line 28 – col. 28, line 22 and col. 32, lines 4-50]; characterized in that the data entities are selected for retrieval by the retrieval system according to the data category, user preferences and then by the position within the geographic region [Hancock, col. 9, lines 18-41, col. 11, lines 9-35, col. 28, line 49 – col. 29, line 67, col. 30, lines 1-10 and col. 32, lines 4-64].

Hancock discloses a user preferences saved on the server but not a user profile identifying specific information subject categories or specific sub-categories of for a user. However, Lumelsky in the same field of endeavor, discloses user profile identifying specific information subject categories or specific sub-categories of for a user and retrieving location-based information with according to one or more of the user's specific information subject categories or specific sub-categories of [Lumelsky, col. 7, lines 3-25 and col. 18, lines 19-57]. It would have been obvious to one or more of ordinary skill in the art to incorporate user interests, taught by Lumelsky, into the

information retrieval system, taught by Hancock, in order to have the search for data be more specific.

Regarding claim 4, Hancock discloses an Internet-connected subscription server system, comprising: a data repository having a plurality of data categories identified by geographic regions [Hancock, col. 5, line 53 – col. 6, line 64, col. 9, lines 42–64 and col. 27, line 28 – col. 28, line 22], each data category having data entities identified and selectable according to position within the boundaries of the category and user preferences [Hancock, col. 11, line 55 – col. 12, line 7, col. 19, line 48 – col. 20, line 15, col. 26, lines 12-41 and col. 27, line 28 – col. 28, line 22, col. 29, lines 25-28 and col. 30, lines 1-10];

a communication module for receiving data requests accompanied by position data; and a code set for managing retrieval of information from the data repository in response to the data requests [Hancock, col. 27, line 28 – col. 28, line 22 and col. 32, lines 4-64]; characterized in the system, receiving a data request from the user, uses the position data within a region accompanying the request to select a data category selects one or more data entities to retrieve according to the position and user preferences [Hancock, col. 9, lines 18-41, col. 11, lines 9-35, col. 28, line 49 – col. 29, line 67, col. 30, lines 1-10 and col. 32, lines 4-64].

Hancock discloses a user preferences saved on the server but not a user profile identifying specific information subject categories or specific sub-categories of for a user. However, Lumelsky in the same field of endeavor, discloses user profile

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identifying specific information subject categories or specific sub-categories of for a user and retrieving location-based information with according to one of the user's specific information subject categories or specific sub-categories of [Lumelsky, col. 7, lines 3-25 and col. 18, lines 19-57]. It would have been obvious to one of ordinary skill in the art to incorporate user interests, taught by Lumelsky, into the information retrieval system, taught by Hancock, in order to have the search for data be more specific.

Regarding claim 7, Hancock discloses the data repository is a first data repository local to the Internet server the system, through the code set, accesses remote Internet-connected information sources, and retrieves information from the remote sources according to stored client interests and the position [Hancock, col. 9, lines 47-64, col. 24, lines 39-59 and col. 28, line 49 – col. 29, line 67] [Lumelsky, col. 7, lines 3-25 and col. 18, lines 19-57].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached UPSTO 892 (if appropriate).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Cardone
Supervisor Patent Examiner
Art Unit 2145

AB